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EXAMINER

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3627

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/728,705
Filing Date: December 01, 2000
Appellant(s): OWEN, EUGENE

MAILED

AUG 26 2004

GROUP 3600

David A. Fox
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 10, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-23 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,483,445	PICKERING	01-1996
5,608,874	OGAWA et al.	03-1997
5,963,925	KOLLING et al.	10-1999
5,943,656	CROOKS et al.	08-1999
6,006,205	LOEB et al.	12-1999
6,049,786	SMORODINSKY	04-2000
6,070,150	REMINGTON et al.	05-2000
6,078,907	LAMM	06-2000
6,128,602	FARHAT et al.	10-2000
6,173,272	THOMAS et al.	01-2001
6,304,857	HEINDEL et al.	10-2001
2002/0007327 A1	STEURY et al.	01-2002
2002/0026394 A1	SAVAGE et al.	02-2002

6,408,284	HILT et al.	06-2002
2002/0103808 A1	OWEN, Jr.	08-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-23 are rejected under 35 U.S.C. 103 as being as being unpatentable over Crooks et al. (5,943,656), in view of Northington et al. (6,128,602). This rejection is set forth in a prior Office Action, mailed on December 12, 2003.

(11) Summary of the Prior Art

Appellant is reminded that what a reference teaches is a question of fact. "What a reference teaches and whether it teaches toward or away from the claimed invention are questions of fact." *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000) citing *In re Bell*, 991 F.3d 781, 784, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). During ex parte examination, examiners are required to make these factual determinations.¹ Thus, the following is a basic discussion of the primary prior art documents, which are of particular interest in this appeal. While all documents of record are not addressed, the documents discussed below are believed to be of significant

¹ See *In re Berg*, 320 F.3d 1310, 1315, 65 USPQ2d 2003, 2007 (Fed. Cir. 2003) ("As persons of scientific competence in the fields in which they work, examiners and administrative patent judges on the Board are responsible for making findings, informed by their scientific knowledge, as to the meaning of prior art references to persons of ordinary skill in the art . . ."); *Waldemar Link GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 558, 559, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994) ("During the prosecution of the parent application, the patent Examiner acts as a fact finder.").

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importance and provide direct or indirect support for the factual and legal conclusion made by either the Examiner or the Board.

Crooks et al.

1. Crooks et al. discloses a computerized billing and payment authorization methods and systems. In particular, the invention concerns utility billing access and payment methods and systems, utility billing access and consolidating methods and systems, and utility provider consolidated billing. Embodiments disclosed in Crooks et al. are directed to a plurality of billing entities provide billing information to a host system, with the billing information being subsequently checked and consolidated into a consolidated amount which can be remotely accessed by a billable entity. Such billing entity can comprise one or more utility providers, e.g. providers of electricity, water, sewage, natural gas, propane, alternate energy sources and/or other related goods or services or processes. Similarly, the term "billable entity" as used in this document will be understood to include an individual or company which is to receive a bill from one or more billing entities. Crooks et al. further discloses that the billing information, which is received from billing entity, is checked against a pre-determined tolerance parameter(s) for determining whether the billing information satisfies such parameter(s), see Crooks et al., Col. 5, lines 41-60.

Northington et al.

2. Northington et al. discloses a system that automatically consolidates information from a plurality of financial systems into a single accounting system with the concept of automatically comparing and *reconciling* two entries. Upon accessing an individual's

account using the system, non-matching transactions may be displayed. Matching transactions may be automatically reconciled and certified by the system. Northington et al. further discloses that transaction verification and reconciliation functions may (1) enable authorized end users to perform transaction verification in order to certify that transactions are accurate; (2) allow authorized end users to override default cost centers or general ledger information; (3) allow authorized end users to dispute transactions according to predefined rules and regulations and track disposition; and (4) *allow authorized end users to request copies of transaction records*. Authorized end users may also request and schedule predefined reports and create and design new report formats and schedules.

(11) Response to Argument

Appellant argues all claims stand or fall together. In accordance with 37 C.F.R. §1.192(c)(7), claims 2-23 stand or fall with claim 1. Therefore, only issues related to claim 1 will be addressed.

The Examiner has established a prima facie case of obviousness for claim 1. Appellant' arguments have not overcome the prima facie case.

Before beginning these arguments, the Examiner notes the following:

Appellant is reminded that during examination, claims are given their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51

(CCPA 1969).² Furthermore, “[a]bsent an express definition in their specification, the fact that appellant can point to definitions or usages that conform to their interpretation does not make the PTO’s definition unreasonable when the PTO can point to other sources that support its interpretation.” *Morris*, 127 F.3d at 1056, 44 USPQ2d at 1029.

To the extent the Examiner’s claim interpretations are different from or in dispute with Appellant’s interpretations, the Examiner hereby adopts the following definitions in all her claim interpretations:

Pre-process: “To do preliminary processing of (as data)” Merriam-Webster’s Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

Process: “2 b: A series of actions or operations conducted to the end;” Merriam-Webster’s Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

Accounts receivable: “Money owed to a business for merchandise or services sold on open account,” Dictionary of Finance and Investment Terms, Fifth Edition, Barron’s Educational Series, Inc., 1998.

In this case, the phrase “pre-process accounts receivable” does not have a common meaning as evidenced by a dictionary or other extrinsic source. However, this does not mean we must ignore the individual words within the phrase. Furthermore, it is the Examiner’s position that Appellant is not his own lexicographer.³ Specifically, it is the Examiner’s factual determination that not only has Appellant failed to point to

² See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

³ While an issue of first impression, it is the Examiner’s position determining if Appellant is his own Lexicographer during examination is a question of fact.

definitional statements in his specification or prosecution history, Appellant has also failed to point to a term or terms in a claim with which to draw in those statements.⁴ Moreover, there are no claim phrases referenced by Appellant with the required clarity, deliberateness, and precision. "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

Finally, §112 6th paragraph is clearly not at issue in this case because Appellant fails to recite "means."

Therefore, the Examiner interprets the claimed "pre-processed account receivable" to mean the phrase "billing information forwarded to the host computer" as recited in Crooks, the claimed "accounts receivable" to mean the phrase "amount for payment by the billable entity" as recited in Crooks, and the claimed "processed accounts receivable" to mean the phrase "checking against pre-determined tolerance parameter(s) to determine whether the billing information satisfy such parameters." Again, the plain and ordinary meaning supports these phrases.

Appellant Specific Arguments

Appellant argues that Crooks "does not teach pre-processed accounts receivable as recited in claim 1. In claim 1, the pre-processed accounts receivable is defined as being the total amount of the accounts receivable inputted to the processing entity by

⁴ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

said carrier.” However, the Examiner notes that in col. 4, lines 42-54, Crooks discloses *billing information* as being associated with a bill or an amount for payment by billable entity 34.

Appellant further states, “In claim 1, the pre-processed accounts receivable is compared to the processed account receivables to determined if sufficient funds have been collected.” The Examiner respectfully notes that the features upon which applicant relies (i.e., to determined if sufficient funds have been collected) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, Appellant has not successfully argued one of the exceptions.

Appellant further argues that Crooks “fails to teach pre-processed accounts receivable that are compared to the accounts receivable to detect a discrepancy”. As stated above, the Examiner has carefully reviewed the specification and prosecution history and cannot locate any lexicographic definition(s). Even if Appellant was his own lexicographer, Crooks discloses that current charges cannot exceed one and one half times the average bill. Therefore, a comparison has to be made to determine if the current charges exceed the average bill by one and one half.

Appellant further argues,
The tolerance parameters in Crooks are based on past billing data. The pre-processed account receivables in claim 1 correspond to total amount of the accounts receivable inputted to the processing entity by said carrier. These are current account receivable data submitted for processing, not an average based on historical data as described in Crooks. The most recent billing data referenced by Crooks is one previous billing cycle (column 5, lines 36-40). Thus, the historical billing data in Crooks used to define the tolerance parameters is not the same as the pre-processed account receivables in claim 1.

The Examiner respectfully notes Crooks discloses that billing information (bill or amount for payment) is inputted in the processing host computer (20) by billing entities (38, 40, 42, 44), which are current charges.

Appellant next argues that

The historical billing data in Crooks cannot be compared to the processed data because the audit process is performed prior to processing the billing information to provide the consolidated amount to each billable entity (col. 6, lines 40- 41). In other words, in Crooks the processed billing information is not even generated if the historical data and the pre-processed data does not match within a certain tolerance.

The Examiner respectfully disagrees. Appellant is reminded that a reference is not only limited to its preferred embodiments. See, e.g., *Ultradent Prods., Inc. v. Life-Like Cosmetics, Inc.*, 127 F.3d 1065, 1068, 44 USPQ2d 1336, 1339 (Fed. Cir. 1997) (noting that it is an error to construe the prior art disclosure as limited to the preferred embodiment). Therefore, it is the Examiner's position that Appellant is relying upon one preferred embodiment to make this conclusion. It is further noted in an alternative embodiment that an estimate can be made based on historical billing information, so that the billable entity receives a consolidated bill, which closely approximates the actual bill. Any overages or underages can be during the next billing cycle (col. 6, lines 62-67).

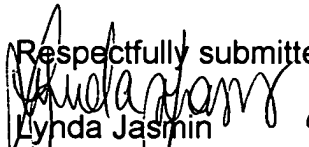
Appellant concludes that

Crooks fails to teach comparing pre-processed billing data to processed billing data. Northington was relied upon for disclosing discrepancy and settlement reporting but fails to cure the deficiencies of Crooks discussed above with reference to claim 1.

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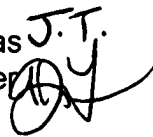
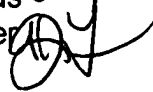
The Examiner agrees that Northington et al. was relied upon for the teaching of creating a discrepancy report and creating a settlement report, and Appellant has not challenge^d that finding.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Lynda Jasmin 8/19/04
Primary Examiner
Art Unit 3627

lj
August 19, 2004

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